

REMARKS

Claims 10-22 are pending. By this Response, claims 10, 11, 14, 15, 16, 18, 19 and 22 are amended. Reconsideration and allowance based on the above amendments and following remarks are respectfully requested.

The Office Action indicates that the reference to Hua, et al. stated in the Information Disclosure Statement was not found in the file and requests a copy of the reference. Applicants hereby provide a copy of the Hua, et al. reference titled "A New Material for Optical, Electrical and Electronic Thin Film Memories".

The Office Action objects to claims 11 and 14 and 15 due to minor informalities. In response, claims 11, 14 and 15 have been amended to correct for these informalities. Accordingly, withdrawal of the objection is respectfully requested.

The Office Action rejects claims 10, 16 and 18 under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. This rejection is respectfully traversed.

Specifically, the Office Action asserts that the recitation of "point, line and/or area potential created between selected electrodes" in claims 10 and 16 and the recitation of "electrode point or line potentials" in claim 18 lack enablement in the specification. Applicants respectfully disagree.

As stated in the MPEP §2164.01, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination

of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the present art to make and use the claimed invention. The standard for determining whether specification meets the enablement requirement was cast in the Supreme Court Decision of *Mineral Separation v. Hyde*, 242 US 261, 270 (1916) which stated that the determination of whether the specification is enabled depends on whether the experimentation needed to practice the invention is undue or unreasonable.

As stated in the M.P.E.P §2164.01(a), there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue”. These factors include, but are not limited to:

- a) the breadth of the claim;
- b) the nature of the invention;
- c) the state of the prior art;
- d) the level of one of ordinary skill;
- e) the level of predictability of the art;
- f) the amount of direction provided by the inventor;
- g) the existence of working examples; and
- h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Applicants respectfully submit that none of the above noted factors have been addressed in the Office Action. Thus, for this reason alone, a proper rejection for lack of enablement cannot be established and therefore the rejection should be withdrawn.

Further, at least on pages 10, lines 25-35 through page 11, lines 1-10 and page 12, lines 33-35 through page 13, lines 1-8, the specification discloses the use of various semiconductor structures including point, line and area potentials in relationship to selected electrodes. For example, page 11, lines 4-6 disclose “capacitors are formed by defining conducting areas, which are aligned mutually opposite in two layers separated by an isolating layer.” Further, page 12, lines 33-34 discloses “a line like structure will be generated, for instance, an electrically conducting structure in the layer SS1”. Further, page 13, lines 4-8 disclose “an electric area structure can be generated in the layer SS1 by this field. In Figs. 2a, 2b, these electrically conducting structures are generated substantially as area structures. However, point or line structures can be generated depending on the manner whereby the electric field is generated.”

Therefore, in view of the disclosure and the specification, one of ordinary skill would be able to make the invention without undue or unreasonable experimentation. Thus, the specification is enabled in relation to the terms recited in the claims and particularly claims 10, 16 and 18. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

The Office Action rejects claims 10-22 under 35 U.S.C. §112, second paragraph as being indefinite. This rejection is respectfully traversed.

The Office Action provides an extensive list of various indefinite claim recitations. Applicants, in response, have amended the claims in order to correct for the antecedent basis and indefinite terms recited in the claims except for the below noted exceptions.

In regard to claims 19 and 20, the Office Action alleges that the limitation “the thin film material” lacks insufficient antecedent basis. Applicants note that both claims 19 and 20 are dependent upon claim 16. In the last paragraph of claim 16, line 3 it recites “a thin film material in a form of a discrete component or a continuous tape”. Thus, sufficient antecedent basis for “the thin film material” in claims 19 and 20 are provided in claim 16.

In regard to claim 22, the Office Action alleges that the recitation of “each separate material layer” lacks insufficient antecedent basis. Applicants note that claim 22 is dependent upon claim 16 and the last line of the first paragraph of claim 16 recites “wherein each material structure is made in the form of a thin layer”. Thus, applicants respectfully submit that the material layer recited in claim 22 is sufficiently recited in claim 16 to provide proper antecedent basis.

In view of the above amendments and arguments, applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

Conclusion

Applicants respectfully submit that the rejection to the claims have been overcome by the amendments and the arguments provided above. Accordingly, applicants respectfully submit that the application is now in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

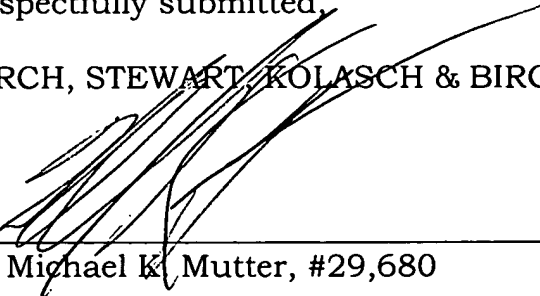
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings (Reg. No. 48,917) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


Michael K. Mutter, #29,680

MKM/ĈJB:cb
2834-0133P

Attachment(s)

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000